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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/910,220	07/20/2001	Charles M. Rowe	01P12721US	2703

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09/25/2002

Siemens Corporation  
Intellectual Property Department  
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EXAMINER

PICKARD, ALISON K

ART UNIT

PAPER NUMBER

3676

DATE MAILED: 09/25/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/910,220

Applicant(s)

ROWE, CHARLES M.

Examiner

Alison K. Pickard

Art Unit

3676

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-21 is/are pending in the application.
- 4a) Of the above claim(s) 1-10 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 11-21 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

### Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☒ Interview Summary (PTO-413) Paper No(s). 2.
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_ 6) ☐ Other: \_\_\_\_

## **DETAILED ACTION**

### ***Election/Restrictions***

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
  - I. Claims 1-10, drawn to a seal assembly having a specific mounting structure for a seal and access structure, classified and search required in class 277, subclasses 370, 551, 572, 576, 577, 586, 641, 642.
  - II. Claims 11-21, drawn to a seal system having a movable/inflatable seal, classified and search required in class 277, subclasses 580, 583, 645, 646.

The inventions are distinct, each from the other because of the following reasons:

2. Inventions of Groups I and II are related as combination and subcombination. Inventions in this relationship are distinct if it can be shown that (1) the combination as claimed does not require the particulars of the subcombination as claimed for patentability, and (2) that the subcombination has utility by itself or in other combinations (MPEP § 806.05(c)). In the instant case, the combination as claimed does not require the particulars of the subcombination as claimed because claims 1-10 relate to a mounting structure for any seal. In fact, claims 1-10 never require further limitations of the seal such as those in claims 11-21. The subcombination has separate utility such as an adaptable (i.e. inflatable) seal system. The subcombination (claims 11-21) never set forth limitations on how the seal is mounted such as those in claims 1-10. In other words, group I is a seal assembly with a seal mounted in a specific way. The seal in Group I can be any seal. Group II is a seal assembly using an inflatable (or adaptable) seal. The seal in Group II can be mounted in any way, or at least, is not limited to the mounting

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requirements set forth in claims 1-10. Groups I and II require completely different searches in class 277.

3. Because these inventions are distinct for the reasons given above and the search required for Group I is not required for Group II (and vice versa), and because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter, restriction for examination purposes as indicated is proper.

4. During a telephone conversation with Terrence Brennan on 9-17-02 a provisional election was made without traverse to prosecute the invention of Group II, claims 11-21.

Affirmation of this election must be made by applicant in replying to this Office action. Claims 1-10 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

***Claim Rejections - 35 USC § 112***

5. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

6. Claim 13 is rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The specification does not appear to disclose a generator stator (second element) sleeved within a ring of a generator rotor (first element) as stated in claim 13.

7. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

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8. Claims 12 and 13 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 12, "the confined space" lacks antecedent basis.

Claim 13 is unclear. Applicant has disclosed that the first element is a ring of a stator while the second is a generator rotor.

***Claim Rejections - 35 USC § 102***

9. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

10. Claims 11 and 14-21 are rejected under 35 U.S.C. 102(b) as being anticipated by Satterthwaite (4,342,336).

Satterthwaite discloses an adaptable seal system comprising a second element 12 or 78 sleeved within a first element to provide a gap. An access structure 48 (or 16) is removably attached to a first element 50 (or 14) (see, for example, col. 9, line 53). A seal 30 or 64 is positioned between the two elements and has a service orientation (Fig. 1) where it does not obstruct the gap and an operation orientation (Fig. 2) where it completely obstructs the gap. As seen in Figures 1 and 5, the seal can be moved into a protected area 54. The seal has hollow portion 37 that is filled with a medium such as gas. The seal is rubber.

***Claim Rejections - 35 USC § 103***

11. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

12. Claims 11-13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Cooper (5,177,385) in view of Satterthwaite.

Cooper discloses generator having a seal between a coil or ring of a stator and a rotor. Cooper does not disclose that the seal is adaptable to attain a service or operation orientation. Satterthwaite teaches an adaptable (inflatable) seal that can attain a service or operation orientation between a stationary member and rotary member. Satterthwaite teaches that using such a seal eliminated the requirement for precision dimensioning. Further, the seal is capable of achieving a varied degree of sealing. The seal is mounted in an element using an access structure (i.e. one half of the structure) for ease in assembly. Therefore, it would have been obvious for one of ordinary skill in the art at the time the invention was made modify the seal of Cooper with the seal as taught by Satterthwaite to provide an effective seal that can be adapted between a service or operation orientation to allow a varied degree of sealing as well as being easier to make and install.

***Conclusion***

13. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The cited prior art discloses various inflatable/adaptable seals.


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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Alison K. Pickard whose telephone number is 703-305-0882.

The examiner can normally be reached on M-F (9-6:30), with alternate Friday's off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Anthony Knight can be reached on 703-308-3179. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9326 for regular communications and 703-8729327 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 308-1113.

  
Alison K. Pickard  
Examiner  
Art Unit 3676

AP  
September 21, 2002